REMARKS/ARGUMENTS

This Response to Office Action, which is filed with an accompanying REQUEST FOR CONTINUED PROSECUTION, is responsive to the Office Action dated June 15, 2005. This Response and the accompanying REQUEST FOR CONTINUED PROSECUTION are filed within six months of the mailing date of the FINAL REJECTION.

Applicants respectfully request further examination and reconsideration in view of the arguments set forth fully below. Claims 1, 15-22 and 36-46 were previously pending in this application. Claims 1, 15-22 and 36-46 have been rejected. By the above amendments, Claims 1, 15-16, 19-20, 22, 36-37, 40-41, and 43-46 have been amended, and Claims 47-49 have been added. No new matter has been added. Accordingly, Claims 1, 15-22, and 36-49 are now pending in this application.

Title

The Office Action states that the title of the invention is not descriptive. While the applicants respectfully disagree, the title has been amended accordingly to expedite issuance of a patent.

Antecedent Basis

The Office Action states that the applicant should provide a clear antecedent basis of each "the" and "said" within each claim. The claims have been amended accordingly.

Rejections under 35 U.S.C. §112

The Office Action states that Claims 43 and 44 refer to a previously cancelled claim. Claims 43 and 44 have been amended accordingly.

Rejections under 35 U.S.C. § 102

Within the Office Action, Claims 1, 15-22, and 36-46 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,903,723 to Beck et al. (hereinafter "Beck"). The applicants respectfully disagree with this rejection.

Beck teaches a method, apparatus, and storage medium for transmitting email attachments from a sender of a network to at least one recipient of the network. Beck's system stores the attachment in a storage device visible to the network with a unique network address. An attachment reference is generated, comprising the network address of the attachment. The attachment reference is transmitted from the sender to the recipient. [Beck, col. 1, lines 62 et seq.] Beck's system further teaches that the system can decide whether to attach an attachment to an email message by reference or value. [Beck, col. 7, lines 54-56] An attachment sent by value means the actual data of a given attachment is transmitted along with the primary email message. [Beck, col. 1, lines 36-41] Beck teaches the determination of whether the attachment is sent by reference or value is based upon a cost figure. [Beck, col. 7, lines 61-63] The cost figure is calculated and set at file replication points [Beck, col. 9, lines 28-33] based upon factors such as transportation and storage costs. [Beck, col. 10, lines 58-62]

Beck does not teach to obtain from a recipient a preferred method for delivery, much less probe a recipient for a preferred method for delivery. For example, Beck teaches the determination of whether the attachment is sent by reference or value is predicated upon a cost figure set by the email system.

To anticipate a claim, a reference must teach each and every element of the claim. In contrast to Beck, Claim 1 includes the language "obtaining from a recipient a preferred method for delivery." Since Beck does not teach "obtaining from a recipient a preferred method for delivery," Beck does not teach each and every element of Claim 1. For at least these reasons, the independent Claim 1 is allowable over the teachings of Beck.

Claims 15-21, and 43-44 are either directly or indirectly dependent on the independent Claim 1. As described above, the independent Claim 1 is allowable over the teachings of Beck. Accordingly, Claims 15-21, and 43-44 are also allowable as being dependent on an allowable claim.

Moreover, dependent Claim 15 includes the language "said obtaining further includes probing a recipient to ascertain at least one preferred format and reformatting and transferring said at least one attachment using said at least one format responsive to said probing." Since Beck does not teach "probing a recipient to ascertain at least one preferred format and reformatting and transferring said at least one attachment using said at least one format responsive to said probing," Beck does not teach each and every element of dependent Claim 15. For at least these additional reasons, the dependent Claim 15 is allowable over the teachings of Beck.

Moreover, dependent Claim 16 includes the language "said making further includes publishing said at least one attachment at a location relatively local to a recipient; initiating a fetch for said at least one attachment; fetching said at least one attachment; presenting said at least one attachment to said recipient; and scanning said electronic mail automatically on a regular basis for one of said links embedded in said electronic mail message and pre-fetching an associated attachment to be cached at a location relatively local to said recipient." Since Beck does not teach "publishing said at least one attachment at a location relatively local to a recipient; initiating a fetch for said at least one attachment; fetching said at least one attachment; presenting said at least one attachment to said recipient; and scanning said electronic mail automatically on a regular basis for one of said links embedded in said electronic mail message and pre-fetching an associated attachment to be cached at a location relatively local to said recipient," Beck does not teach each and every element of dependent Claim 16. For at least these additional reasons, the dependent Claim 16 is allowable over the teachings of Beck.

Moreover, dependent Claim 43 includes the language "said obtaining further includes probing the recipient to ascertain at least one caching location and transferring said at least one attachment using said at least one caching location responsive to said probing." Since Beck does not teach "probing a recipient to ascertain at least one caching location and transferring said at least one attachment using said at least one caching location responsive to said probing," Beck does not teach each and every element of dependent Claim 43. For at least these additional reasons, the dependent Claim 43 is allowable over the teachings of Beck.

Moreover, dependent Claim 44 includes the language "said obtaining further includes probing a recipient to ascertain at least one transfer protocol for delivery of said at least one attachment and transferring said at least one attachment using said at least one transfer protocol responsive to said probing." Since Beck does not teach "probing a recipient to ascertain at least one transfer protocol for delivery of said at least one attachment and transferring said at least one attachment using said at least one transfer protocol responsive to said probing," Beck does not teach each and every element of dependent Claim 44. For at least these additional reasons, the dependent Claim 44 is allowable over the teachings of Beck.

Claim 22 includes the language "obtaining from a recipient a preferred method for delivery." Since Beck does not teach "obtaining from a recipient a preferred method for delivery," Beck does not teach each and every element of Claim 22. For at least these reasons, the independent Claim 22 is allowable over the teachings of Beck.
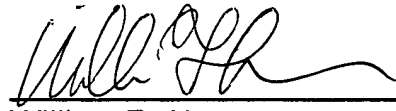
Claims 36-42 and 45-46 are either directly or indirectly dependent on the independent Claim 22. As described above, the independent Claim 22 is allowable over the teachings of Beck. Accordingly, Claims 36-42 and 45-46 are allowable at least for being dependent on an allowable claim.

New Claims

The applicants have added new Claims 47-49. No new matter has been added. The claims are believed to be allowable for reasons similar to those described with reference to Claims 1, 15-22, and 36-46.

No new subject matter has been added by way of the above amendments. For the reasons given above, the applicants respectfully submit that Claims 1, 15-22, and 36-49 are now in a condition for allowance. The applicant respectfully requests that all rejections be withdrawn and the application be allowed at the earliest date possible. Should the Examiner have any questions or comments, he is encouraged to call the undersigned at (650) 838-4305 to discuss the same so that any outstanding issues can be expeditiously resolved.

Respectfully submitted,
Perkins Coie LLP

Date: <u>October 6, 2005</u>

William F. Ahmann
Reg. No. 52,548

Correspondence Address:
Customer No. 22918
Perkins Coie LLP
P.O. Box 2168
Menlo Park, California 94026
(650) 838-4300